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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,238	03/02/2004	Kevin M. Lewandowski	59520US002	4771
32692 7590 04/12/2007 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER SILVERMAN, ERIC E	
			ART UNIT	PAPER NUMBER
			1615	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		04/12/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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LegalDocketing@mmm.com

Office Action Summary	Application No. 10/792,238	Applicant(s) LEWANDOWSKI ET AL.	
	Examiner Eric E. Silverman, PhD	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' reply, filed 2/14/2007, has been received. Pursuant to amendment, claims 1 – 5 and 7 – 32 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of claims 1 – 5 and 7 – 24 as provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 23 of commonly assigned US Patent No. 7,074,839 is **withdrawn** in view of the terminal disclaimer filed 2/14/2007.

The provisional rejection of claims 1 – 5 and 7 – 34 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 34 of

copending Application No. 10/672,580 is **moot** since the copending application has gone abandoned (notice of abandonment mailed 3/12/2007).

Claims 1 – 5 and 7 – 24 **remain** provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 45 of copending Application No. 10/732,715 for reasons of record and those discussed below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicants' arguments have been fully considered, but are not persuasive. Applicant argues that instant claim 1 distinguishes from the copending application because instant claim 1 requires ethylenically unsaturated polymerizable groups, whereas the functional groups of the copending case are nucleophilic or electrophilic. This is not persuasive because ethylenically unsaturated groups are also nucleophilic or electrophilic. For example, the artisan would recognize that such groups (also known as olefins) may act as electrophiles in the presence of water or alcohols and react to form hydrates or solvates. Also, in the presence of cationic or anionic polymerization initiators, olefins act as nucleophiles or electrophiles (respectively) during the polymerization reaction. Since ethylenically unsaturated polymerizable groups are nucleophilic or electrophilic, Applicants' argument is not persuasive and the rejection is maintained.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 18, and 19 **remain** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection of claims 5, 15 and 22 under this statute is **withdrawn** in view of amendments and Applicants' persuasive arguments. The rejection of claim 6 under this statute is **moot** since claim 6 is cancelled. With respect to claims 4, 18, and 19, the rejection is maintained for reasons of record and those discussed below. In view of the amendment, **new claim 32** is now included in this rejection.

Claim 32 is rejected for use of the indefinite phrase "derived from". Without a limiting definition in the specification, the artisan would not be aware of what materials may be "derived from" those recited in the claim, and as such, would be unable to determine the metes and bounds of the claimed invention.

Response to Arguments

Applicants' arguments have been fully considered, but are not persuasive.

With regard to claim 4, Applicants' argue that residual is define at page 17, lines 10 – 18 and page 18, line 3 of the specification. The entire disclosure has been carefully reviewed by the examiner, with special attention given to these cited sections. The cited sections do not in fact define the term "residual". These sections speak of "residual monomer and/or solvents", but not of "residuals". It is suggested that Applicants might overcome this ground of rejection by replacing "residuals" with

"residual monomer and solvents". The specification at page 17, lines 10 – 18 has support for this language.

With regard to claim 18, Applicant argues that the term "partially" is supposed to modify the word "converted" not "viscosity" or "composition". This being understood, the meaning of the claim is still not clear. Specifically, how can a material be "partially converted" to a particular viscosity? It is not clear if the claim is trying to convey that the composition is altered in such a manner as to change the viscosity to the recited amounts, or if the process of altering the viscosity is begun, but not completed (thus, "partially converted"). If the latter, what is the viscosity of the composition of this claim? Either a composition has a particular viscosity or it does not – a composition cannot be "partially converted" to a particular viscosity.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 5, and 7 – 31 **remain** rejected under 35 U.S.C. 102(a) or 102(e) as being anticipated by WO 2003/086492 for reasons of record and those discussed below. In view of amendment, **new claim 32** is now included in this rejection.

As a preliminary matter, Applicant had requested clarification as to which statute was being applied to this claim. The WO reference qualifies as prior art under both 35

USC 102(a) and 102(e), and thus is an anticipatory reference under either section of the statute.

Applicant argues that the claims are different from the art because the "pendant" olefins of the claims are not the same as the end-group olefins in the art. This is not persuasive, because, as acknowledged by Applicant, the WO document teaches branched materials, and the groups on the branches are understood to be pendant. Also, there is nothing to indicate that the terminal groups of the art cannot read on the pendant groups of the claim. Applicant also believes that the claims differentiate from the art because, according to Applicant, the polymers in the claims must have a carbon-carbon backbone as a result of being made from olefins, while those in the art have a poly(oxyalkylene) backbone. This is not persuasive because the claims do not require that the oligomers recited therein be made from olefinic monomers, on the contrary, the claims merely require that the monomers have olefinic pendant groups. Applicants' continue to argue that the claims differentiate because the claims require two different components. It is believed that by this, Applicants mean that the claims require component a) (a first component...) and component b) (a hydrophilic poly(alkylene oxide)... to be separate entities. The art meets this limitation. The PAO macromer of the art (described on page 6 of the previous office action) is component a) and the multifunctional initiator (described on pages 6 – 7 of the previous office action) is component b). In fact, Applicants' concede that component b) reads on the reference compounds at col. 3, lines 62 – 64 of the reference. If Applicant had intended the claims or the argument to mean something other than this, then further clarification is

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needed. Applicants' also believe that the method used to prepare instant compositions would make them different even if the components are the same. However, there are no limitations in the claims drawn to these different method steps. This argument is understood to apply only to the process claims, not to the product claims.

With regard to newly added claim 31, due to the indefinite nature of this claim, wherein it is not certain what may be "derived from" the structured drawn therein, it is believed that the materials of the WO reference may be so derived, and thus, they read on this claim as well.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric E. Silverman, PhD
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MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1610